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EXAMINER

FERRIS, DERRICK W

ART UNIT PAPER NUMBER

2616

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/020,783	Applicant(s) WENGROVITZ, MICHAEL	
	Examiner Derrick W. Ferris	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 1-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election 26-47 in the reply filed on 2/17/2006 is acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 26-47** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the above claims are related to newly added claimed subject matter for preliminary amendment filed 5/19/2005. Applicant provided no support for the above newly added limitations in the preliminary amendment. As such, for applicant's **claims 26-35** and claim 26 in particular, no support was found for the further limitation of *in response* (to a server receiving a call establishment message), causing retrieval of information stored *in the first device*. In particular, applicant's specification at page 5, second full paragraph and withdrawn claim 7 teach retrieving caller information from a data store on the first device but does not further teach retrieving the information *in response to* a call establishment message. In particular, the above-cited sections *teach away* from the newly added claim limitation since the call establishment message uses the retrieved information. Applicant's figure 6 and pages 13-14 further support that the call establishment message is sent *after* the call information is retrieved

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since step 216 occurs after step 210. In addition, applicant's specification at first full paragraph of page 10 (and last paragraph of page 10) teaches retrieving information from the location server 58 and database 57 (and not a first device). The paragraph at the bottom of applicant's specification at page 9 teaches that caller information may be written by the server 56 or calling end-point 50 during or after a call but does not further teach *retrieving* information and is also further silent or deficient to retrieving in response to a call establishment message. Thus the above-cited sections also do not cure the above-mentioned claim limitation with respect to retrieving information. In addition, for claim 29, the further limitation of transmitting an address *of the web server* to the first device is further not supported by applicant's specification. In particular, applicant's specification teaches transmitting the address of the second device and not the address of the web server, see e.g., applicant's specification at first full paragraph on page 10. Claims 27-35 are rejected for depending on rejected claim 26. **Claims 36-44** are also rejected for the same reason as rejected claim 26 above with respect to the further limitation of *in response*, transmits an address of the second server to the first device for causing retrieval of information stored in the first device. In addition, the further limitation of transmitting an address *of the second server* to the first device is further not supported by applicant's specification. In particular, applicant's specification teaches transmitting the address of the second device and not the address of the second server, see e.g., applicant's specification at first full paragraph on page 10. As such, for applicant's **claims 45-47** and in particular for claim 45, no support was found for a server coupled to the user device *that hosts a web site*. In particular, applicant's specification at the second full paragraph on page 9 references sending a call initiation message (i.e., SIP INVITE) that may contain caller information that is associated with a web site domain.

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No further evidence is provided that supports a server that hosts a web site where the server is coupled to the user device. Furthermore, the following limitation of a SIP server that initiates an outbound call to the user device in response *to user interactions with the website* is not further supported in the above cited paragraph. Furthermore, applicant's specification at page 13 also does not cure the above-mentioned deficiencies. In particular, page 13 clarifies that the browser is resident at the calling end-point but is silent or deficient as to the further location of the web server. The examiner would like to further point out that it appears that the location server is not a web server, see applicant's specification at e.g., bottom of page 8, bottom of page 12 and top of page 13 since a location server does not contain attributes of a web server. Claims 46 and 47 are further rejected for depending on claim 45. **Claims 29-33** are also rejected based on a similar rejection for claim 45. In particular, applicant's specification does not appear to further teach a web server coupled to the server.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 29-33, 36-44 and 45-47** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, **claims 29-33** are rejected since for claim 29 the term "web server" was not found in applicant's specification. Please point out any logical equivalents to "web server" in the specification. **Claim 30** is further rejected since the term "hypertext markup language link" (or HTML) was not found in applicant's specification. Please point out any logical equivalents to "hypertext markup language link" in the specification.

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Claims 30 and 31 are further rejected since the term “the address” lacks proper antecedent basis. Please clarify which limitation references the address (i.e., parent claim 26 recites an address of the second device and parent claim 29 recites an address of the web server). **Claims 36-44** are rejected since for claim 36 the term “the server” at line 5 lacks proper antecedent basis. Please clarify whether “the server” is the first server or the second server. Claim 36 is further rejected since the term “the address” at line 6 lacks proper antecedent basis since it is unclear whether the above term refers to an address of the second server or an address of the second device as recited in the claim. **Claim 39** is further rejected since the term “hypertext markup language link” (or HTML) was not found in applicant’s specification. Please point out any logical equivalents to “hypertext markup language link” in the specification. **Claims 39 and 40** are further rejected since the term “the address” lacks proper antecedent basis. Please clarify which limitation references the address (i.e., parent claim 36 recites an address of the second server and an address of the second device). **Claims 45-47** are rejected since for claim 45 the term “server hosting a web site” was not found in applicant’s specification. Please point out any logical equivalents to “a server hosting a web site” in the specification.

6. **Claims 36-44** are rejected as failing to define the invention in the manner required by 35 U.S. 112, second paragraph.

In particular, claim 36 is narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. Please rewrite claim 36 in similar *format* as e.g., claim 26. **Claims 37-44** are rejected for depending on claim 36.

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The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 26-28, 36-44** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,744,759 B1 to *Sidhu et al.* (“*Sidhu*”).

As to **claim 26**, see e.g., figure 2a where a first device is user A 208a and second device is user b 218a and a server is part of the local telephony connection server 150a. Thus the server is operative between the first device and the second device as illustrated by the figure. The first device transmits a call establishment message as a SIP INVITE message, see e.g., column 13, lines 19-46. The server further determines an address of the second device based on the retrieved information and uses the address for routing the SIP session to the second device as part of the SIP protocol, see e.g., column 13, lines 4-60 and column 16, line 66 – column 17, line 8. In particular, the information provided in the SIP INVITE protocol (retrieval of information from a first device) is used to perform a database lookup of users B’s destination address in database 152b. In addition,

information is further retrieved from information stored in the first device with respect to a registration request message, see e.g., columns 13-14. For example, the SIP INVITE message contains the SIP URL obtained from the redirect server where a database lookup is then performed based on the SIP information which was retrieved from the first device via the redirect server to determine the destination.

As to **claims 27-28**, see e.g., table A in columns 14-15 which contains information that reads on information gathered about a user of the first device and interactions of a user with a particular web site.

As to **claim 36**, see similar rejection to claim 26. In addition, a second server is taught as a redirect server, proxy server, or registrar server, see e.g., column 13, lines 6-17.

As to **claim 37**, see similar rejection to claim 27.

As to **claim 38**, see similar rejection to claim 28.

As to **claim 39**, *Sidhu* further teaches SIP-URLs which is HTML, see e.g., column 13, lines 19-31.

As to **claim 40**, *Sidhu* teaches transmitting SIP messages, see e.g., column 13, lines 19-31 where the SIP message is either the SIP INVITE or the SIP register message.

As to **claims 41-42**, see similar rejection to claim 36 with respect to a second server where the information is contained in the SIP message.

As to **claim 43**, *Sidhu* teaches storing the information in the database which is used for future calls, see e.g., column 16, lines 36-39.

As to **claim 44**, the local telephony connect server 150a transfers the call to the end user (e.g., user B) after performing the lookup in the database, see e.g., column 13, lines 1-4.

Claim Rejections.- 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 29-35 and 45-47** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,744,759 B1 to *Sidhu et al.* ("*Sidhu*") in view of U.S. Patent No. 6,612,899 B1 to *Sollee et al.* ("*Sollee*").

As such to **claim 29**, *Sidhu* discloses a telephony connections server 150a (i.e., a redirect server, proxy server, and registrar server) but may not expressly teach that the telephony connections server is a web server, see e.g., column 13, lines 4-16 thus meeting the further limitation of a web server coupled to the server. However, *Sidhu* does teach that the above servers may be coupled to each other. In addition, *Sidhu* teaches that web based applications can be used, see e.g., column 16, lines 9-25.

Sollee teaches the further recited limitation above at e.g., column 5, lines 30-45.

The proposed modification of the above-applied reference(s) necessary to arrive at the claimed subject matter would be to modify telephony connections server 150a by further including a web server.

As such, examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the above limitation. In particular, the motivation for modifying the reference or to combine the reference teachings would be to perform a click-to-call service as well as downloading an applet. In particular, *Sollee* cures the above-cited deficiency by providing a motivation found at e.g., column 5, line 30-50.

As to **claim 30**, *Sollee* further teaches HTTP which is HTML, see e.g., column 5, lines 46-50. The examiner notes the same motivation above for the parent claim. *Sidhu* further teaches SIP-URLs which is HTML, see e.g., column 13, lines 19-31.

As to **claim 31**, *Sidhu* teaches transmitting SIP messages, see e.g., column 13, lines 19-31 where the SIP message is either the SIP INVITE or the SIP register message.

As to **claims 32-33**, see similar rejection to claim 29 with respect to a web server where the information is contained in the SIP message.

As to **claim 34**, *Sidhu* teaches storing the information in the database which is used for future calls, see e.g., column 16, lines 36-39.

As to **claim 35**, the local telephony connect server 150a transfers the call to the end user (e.g., user B) after performing the lookup in the database, see e.g., column 13, lines 1-4.

As to **claim 45**, see similar rejection to claim 29 with respect to a web server. With respect to stored information, see e.g., the SIP register, SIP invite and SIP ACK messages, see e.g., columns 13-14 of *Sidhu*.

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As to **claims 46 and 47**, the local telephony connect server 150a transfers the call to the end user (e.g., user B) after performing the lookup in the database, see e.g., column 13, lines 1-4.

Conclusion

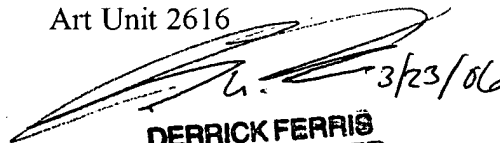
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (571) 272-3123. The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (571)272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DWF

Derrick W. Ferris
Examiner
Art Unit 2616


3/23/06
**DERRICK FERRIS
PATENT EXAMINER**